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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,549	06/19/2001	Michael J. Lemon	10007916-1	2371

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EXAMINER
LIU, MING HUN

ART UNIT	PAPER NUMBER
2697	5

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/884,549	LEMON, MICHAEL J.	
	Examiner	Art Unit	
	Ming-Hun Liu	2697	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-15 and 17-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-15 and 17-20* is/are rejected.

7)☒ Claim(s) *1,3,5,8 and 15* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. The amendments concerning the claims have been acknowledged and will be entered.

Claim Objections

2. Claims 1, 3, 5, 8, and 15 are objected to because of the following informalities:

- In claim 1, the term "data address" should be clarified to read "internet data address" as it corresponds to the preamble of the claim. It is unclear what type of data address the claim is referring to.
- In claim 3, the meaning of the term "free form image" is ambiguous and should be clarified.
- In claim 5, the term "computer-accessible sites", should be clarified further to read "computer-accessible internet address sites."
- In claim 8, the term "addresses", should be clarified further to read "Internet associated computer data addresses" as consistent with the preamble.
- In claim 15, the term "address", should be clarified further to read "internet site address."

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,091,409 to Dickman et al.

In reference to claim 1, Dickman discloses a computer annotator system comprising for accessing internet data addresses, that associates at least one temporarily marked location on the screen with a preselected data address and later accessing the marked location with a pointer that triggers a shift to the data address associated with the marked location (figure 4, column 4, lines 42-46 and column 6, lines 38-49).

Dickman however does not teach that in an electronic table with a marketing stylus be used with the system.

It would have been simple to utilize a tablet and stylus as an input manipulation means, since tablets are oftentimes manufactured specifically for the use with computers.

It would have been obvious to one skilled in the art to use a tablet and stylus as an input method because of the extreme conventionality of the input device and it's common use as a substitute to the mouse input device.

In reference to 2, Dickman teaches a surface region where the annotating function is implemented, namely the shell space or desktop of the system (column 4, lines 44-46).

In reference to claim 3, it can be seen from figure 9d, that there is a second region accessible by the input device where an image indicative of the data address is entered.

Claims 8-10 are rejected on the same grounds of rejection for claims 5-7.

Claims 5-7, 11-15 and 17-20 are rejected on the grounds discussed in the previous office action dated 4/11/03.

Response to Arguments

5. Applicant's arguments, see amendment A, filed 6/26/03, with respect to the rejection(s)of claim(s) 1-3 and 8-10 under Makino have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Dickman.

The arguments against the rejection of claims 1-3 and 8-10 have been noted and recognized as factually correct. It is agreed upon that Makino's invention is different from the invention being disclosed, however such difference were not clearly exemplified in the claim language offered in the previous action. In other words, the claims were drafted in such a general sense that the Makino reference could have been used to anticipate the claimed invention.

In reference to the arguments concerning claims 5-7, the term "computer accessible sites" is ambiguous and too general therefore the grounds of rejections have not been changed. Even if the applicant chooses to amend the claims to specify "computer accessible sites" to "computer Internet accessible sites", the claim can still be anticipated by Dickman since it is well known to people skilled in the art since 1995, that shortcuts are inherently designed to be placed in random locations, erased, and be placed over the desktop in random locations. The applicant should differentiate claims 5-7 from Microsoft's internet shortcut by elaborating on the idea of linking

the handwritten mnemonic symbol to the Internet address and having the mnemonic symbol remain on the screen where it can be accesses by referring again to the handwritten mnemonic symbol.

Applicant's arguments against the rejection of claim 15 are deemed unconvincing. It is true that the method in which the two inventions associate actions or addresses differ, however this distinction is not reflected in the claim language. The claim has been amended with "computer code for accessing said address." This highly resembles a macro, a series of computer code associated to perform a function, a limitation that is clearly anticipated by Dupony.

Referring to applicant's arguments concerning claims 11, 12 and 14. It is true that the method in which the Lemon (Resource) and Dupony (Command) are different. However the claim is written in a way that such a distinction is not present. The arguments concerning the specific method of implementation is inapplicable since the claim does not claim the details being argued.

In summary, the applicant's explanations of how Dupony's method of reference to an address is dissimilar to the one being claimed is correct, however this distinction must be reflected explicitly in the claim writings.

In conclusion, the claims of the invention should be drafted so that applicant's invention can be clearly distinguished form Dupony and Dickman's disclosures. The applicant must emphasize the exclusivity of associating the process specifically to bookmarking Internet addresses to remove any ambiguity of the type of address. The applicant must also further differentiate his invention from Microsoft's internet shortcut invention by elaborating on the

specific idea of linking the handwritten symbol made with the stylus to the Internet address and having the mnemonic symbol remain on the screen where it can be accesses.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,184,864 to Chao: Internet abilities with tablet i/o.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ming-Hun Liu whose telephone number is 703-305-8488. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mancuso can be reached on 703-305-3885. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

Ming-Hun Liu